UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/201,107	11/30/1998	CHRISTIAN MAYAUD	CM3-CON	1150

20822 7590 11/30/2004

RUDEN, MCCLOSKY, SMITH, SCHUSTER & RUSSELL, P.A.
P.O. BOX 1900
FORT LAUDERDALE, FL 33301

EXAMINER	
BLECK, CAROLYN M	

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/201,107	MAYAUD, CHRISTIAN	
	Examiner	Art Unit	
	Carolyn M Bleck	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 August 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *71-73,75 and 85* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *71-73,75 and 85* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 August 2004 has been entered.

2. This communication is in response to the RCE filed 26 August 2004. Claims 71-73, 75, and 85 are pending. Claims 1-70, 74, and 76-84 have been cancelled.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 71-73, 75, and 85 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 23 of U.S. Patent No. 5,845,255. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 23 of '255 discloses the features of claim 71. In particular, claim 23 discloses a system comprising a prescription creation screen having prescriber operable data capture including patient-identifying data, prescribed drug identification data, drug quantification data, and before completion of the prescription, automatically displaying multiple prescribable drugs from a library of prescribable drug data accessible by one or more of said data capture devices from said prescription management screen, at least one of said displayed multiple drugs being identified as a patient's drug formulary preference for treatment of said condition, to facilitate selection by said prescriber of a benefit plan recommended drug, whereby the patient's drug formulary preference for treatment of said condition is system-presented to the prescriber prior to completion of the prescription. It is noted that the claims are not patentably distinct from each other because claim 71 of the present application is broader in scope to the systems and methods recited in claim 23, respectively, of U.S. Patent No. 5,845,255. That is, claim 71 of the present application falls entirely within the scope of claim 23 of U.S. Patent No. 5,845,255, or in other words, claim 71 of the present application is anticipated by claim 23 of U.S. Patent No. 5,845,255. The same analysis can be applied to claims 72-73, 75, and 85 of the present application and claims 1, 10, and 11 of U.S. Patent No. 5,845,255.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 71-73, 75, and 85 rejected under 35 U.S.C. 102(e) as being anticipated by Schrier et al. (6,317,719).

(A) As per claims 71 and 85, Schrier discloses teaches a prescription creation screen permitting prescriber operable data capture including patient id, prescribed drug, drug quantification, and patient condition (col. 13, lines 5-15, col. 6, lines 4-25, col. 8, lines 35-50, col. 9, lines 10-35), a library of prescribable drug data accessible from the prescription creation screen to display multiple drugs (col. 5, lines 30-67, col. 13, lines 60 - col. 14, line 45)., a prescription output screen to output the completed prescription including patient condition, identification, and quantification (col. 13, lines 10-16). Schrier also teaches information regarding prescribability of the drug according to patient condition (col. 8, lines 35-60, col. 9, lines 35-65, col. 11, lines 30-40, col. 13, line 60 – col. 14, line 30); drug formulary information identifying at least one of multiple drugs as the patient's drug formulary preference (col. 13, line 60 – col. 14, line 30).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 72-73 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schrier et al. (6,317,719) as applied to claim 71, and further in view of Battaglia (5,088,037).

(A) The teachings of Schrier discussed in the rejections above, are incorporated herein.

Battaglia teaches selecting patient condition from a group of possible conditions (col. 3, line 65 - col. 4, line 25). It would have been obvious to one having ordinary skill in the art at the time of the invention to have selected a condition from possible conditions as in Battaglia in the system of Schrier since the interface of selecting a condition from possible conditions would have provided a user friendly interface by removing possible typing errors and since it automatically branches to possible treatments which would include treatments including prescriptions.

9. Claim 85 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brimm et al. (5,072,383).

(A) As per claim 85, Brill discloses a display screen (Fig. 5, col. 5 line 59 to col. 6 line 22) for a physician to enter an order, e.g., medication orders, wherein the order includes the patient's name, medication name, the dosage of the medication, and the patient's condition (such as for pain, see Fig. 6) (Fig. 5-6, col. 9 lines 1-42), a listing of medications for a physician to chose from by placing the cursor over the item, a terminal to output the orders (i.e., a prescription), wherein the orders includes the patient's condition and drug information and treatment information (Fig. 5-6, col. 9 lines 1-42).

Brill does not expressly disclose a library of drugs. However, the Examiner respectfully submits that because a user is able to select the drug from a list, the name of the drug and other information about the drug would need to be stored in a computer (i.e., see the file server of Brill, Fig. 2). The motivation being to quickly and easily retrieve organized information.

Affidavit

10. Applicant has submitted an affidavit to remove Schrier et al. (6,317,719) as a reference applied under 35 U.S.C. §§ 102(e) and 103(a) in the previous Office Action (5 January 2004). The 1.131 affidavit filed on 4 June 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Schrier et al. (6,317,719) reference.

(A) The affidavit states in sections 3-8 that Applicant made a confidential presentation to a third party regarding the invention "Physicians' Online." Applicant refers to exhibits A-G as demonstrating the "Physician's Online" product.

It is unclear to the Examiner whether the confidential presentations in exhibits A-G are evidence of the invention being reduced to practice or evidence of conception. If these exhibits are evidence of reduction to practice as of December 13, 1993, the Applicant is not required to show due diligence as discussed in sections 12 and 13 of the affidavit. If these exhibits are evidence of conception as of December 13, 1993, the Applicant is then required to show due diligence up until the point of reduction to practice.

The affidavit (sections 1-9, 11, and 13) and exhibits (A-I) are insufficient because the affidavit and exhibits are not commensurate in scope with the claimed invention. In particular, it is respectfully submitted that the affidavit broadly discusses claims 71 and 85 of the present application, but the affidavit fails to tie the exhibits A-I to the features of the claimed invention. In particular, the affidavit does not demonstrate where the features, for example "a library of prescribed drug data..." and "drug formulary information..." of claim 71, are found in exhibits A-I. Appropriate clarification is requested.

Response to Arguments

11. As Applicant fails to provide any further arguments other than the reliance on Affidavit evidence that is ineffective to remove the Schrier reference for the reasons given above, the rejections are hereby maintained.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied prior art teaches a pen-based form computer (5,347,477), a non-prescription drug medication screening program (5,299,121), an analytical computer for chemical compatibility prescriptions (SU 561953), prescription selector (JP 03191952), data entry unit for a medical practitioner (JP 0540768), method and device for issuing prescriptions (JP 06223089), and numerous articles (see 892 Form).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-3981. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 306-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

14. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9306 or (703) 872-9326 [Official communications]

(703) 872-9327 [After Final communications labeled "Box AF"]

(703) 746-8374 [Informal/ Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor (Receptionist).

CB
November 18, 2004

ALEXANDER KALINOWSKI
PRIMARY EXAMINER